

REMARKS

Reconsideration of the above-identified application is respectfully requested. Claims 1-7 are pending, Claims 8-14 have been cancelled, and Claims 15-20 have been added to particularly point out and distinctly claim the novel aspects of the present invention. Additionally, Applicants have submitted an Abstract on a separate sheet of paper to comply with CFR 1.72(b).

Claims 1-7 were rejected in an April 18, 2001 Office Action (hereinafter "Office Action") under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 4,420,515 to Amon et al. (hereinafter "Amon et al.") in view of U.S. Patent No. 4,215,170 to Vilaprincho Oliva (hereinafter "Vilaprincho Oliva") and U.S. Patent No. 5,569,512 to Brawner et al. (hereinafter "Brawner et al."). Claim 7 was further rejected under 35 U.S.C. § 112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Further, Claim 6 has been objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. Applicants respectfully disagree with the prior art rejection, and have amended the claims to overcome the § 112, second paragraph rejection and the improper multiple dependency objection. The reasons why Applicants disagree with the rejections cited in the Office Action and believe that the claim of the present application are allowable are discussed below. Following is a brief description of the invention and a brief description of the cited prior art.

Applicants' Invention

The present invention is directed toward a printed document, such as a bank note, having a counterfeiting prevention feature. The document includes a substrate, which can be a polymer film or paper, having a surface to which printed matter is applied. The document also includes a reflective or brightly coloured layer applied to the surface of the substrate by a Gravure process.

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{LLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100



The reflective or brightly coloured layer can be ink, which produces a reflective or brightly coloured effect, or a reflective foil typically comprising a carrier film, a release layer, a metalized layer, and an adhesive. After the reflective or brightly coloured layer is applied, printed matter is then applied to the surface of the reflective or brightly coloured layer by the Intaglio process to produce a print having raised regions. The raised regions of the printed matter form an image, which is significantly enhanced by the reflective or brightly coloured background when viewed under different lighting conditions and viewing angles.

Amon et al.

Amon et al. discloses a metallization process for protecting documents of value. The process includes laminating an extremely thin metallic film to a portion of the substrate of the valuable document before the document is printed. The selectively metalized document substrate is then simultaneously printed and embossed. During this process, printing is applied solely to locations on the substrate other than the metalized film, and embossing is applied only to the metalized film to form a latent image in the metalized film. The latent image in the metallic film is thereby formed during the embossing process without the use of ink.

Vilaprinyo Oliva

Vilaprinyo Oliva discloses a process for the metallization of a substrate and the product formed. The process begins with a substrate in web or sheet form, constructed from any suitable material such as paper, cardboard, wood, leather, or plastic. Next, an extremely thin coat of metallic particles are deposited on a transfer agent. A thin coat of varnish is then applied to either the substrate or the transfer agent, and the substrate and the transfer agent are laminated together. The metallic particles are absorbed within the varnish, and the substrate and transfer agent are then separated. The final product formed is a substrate having a highly polished specular metallic finish.

B

Brawner et al.

Brawner et al. discloses cards, such as instant-win lottery tickets, having hidden symbols to prevent players from successfully tampering with the cards. The card includes a paper base to which various ink layers and coatings may be applied to enhance the security of the cards. A foundation coating may be included the covers a portion of the base in the secure area to increase the opacity of the card.

CLAIM OBJECTION

Claim 6 stands objected under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. Applicants have amended Claim 6 to depend from Claim 2 only. Additionally, Claims 15 and 16, which are identical in substance to Claim 6, have been added to depend from Claims 3 and 5, respectively. Therefore, Applicants respectfully request withdrawal of the pending objection to Claim 6.

REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claim 7 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, in Claim 7, line 2, the phrase "the opaque layer" is indefinite for lacking proper antecedent basis in the claim. Applicants have amended Claim 7 to depend from Claim 4, which provides proper antecedent basis for "the opaque layer". Therefore, Applicants respectfully request the withdrawal of the pending rejection under § 112, second paragraph, with regard to Claim 7.

REJECTIONS UNDER 35 U.S.C. § 103(a)

Claims 1-7 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Amon et al. in view of Vilaprinyo Oliva and Brawner et al. The Office Action states that Amon et al. discloses a document having a paper or other substrate having a smooth or rough surface, a metalized film

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

B

onto the substrate and an image layer onto the metalized film. However, the Office Action states that Amon et al. does not disclose the claimed image thickness. Although Amon et al. does not disclose the claimed image thickness, the Office Action contends at the time of the invention, a person of ordinary skill in the art would have been motivated to vary the image thickness to ensure visibility from an angle. The Office Action supports this contention by stating that experimental modification of prior art in order to optimize operating conditions fails to render claims patentable in the absence of unexpected results. Additionally, VilaprinYO Oliva was cited for the use of a plastic substrate, while Brawner et al. was cited for teaching an opaque layer, such as titanium dioxide pigment, as a contrasting layer to be applied to the substrate.

Applicants agree with the Office Action that Amon et al. does not teach the claimed image thickness. However, Applicants respectfully submit that one of ordinary skill in the art would not have been motivated to vary the thickness of Amon et al. to ensure visibility from an angle. Additionally, Applicants respectfully submit that Amon et al., VilaprinYO Oliva, and Brawner et al. fail to teach or suggest a printed image being applied to a reflective or brightly coloured layer by a printing process. Therefore, Applicants respectfully traverse the rejection of these claims.

Independent Claim 1

Independent Claim 1 recites a document including a substrate, a reflective or brightly coloured layer, and a "raised printed image applied to said reflective or brightly coloured layer by a printing process." This configuration provides a security feature formed by the application of a raised printed image to a reflective or brightly colored layer during a printing process. In contrast, Amon et al. teaches the lamination of an extremely thin metallic film onto a portion of a substrate, such that the metallic film does not cover the entire area of the substrate. During a simultaneous printing and embossing process, printing is applied solely to locations other than

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100



the metalized film, and embossing is applied only at the metalized film to form a latent image in the metalized film. Thus, the latent image is thereby formed by embossing without the addition of a raised printed image on the metallic film surface. Because Amon et al. specifically excludes the use of a printed image on the metalized film by embossing the latent image, Amon et al. fails to teach or suggest "a raised printed image applied to said reflective or brightly coloured layer by a printing process", as recited in independent Claim 1. Further, Applicants submit that Vilaprinyo Oliva and Brawner et al. also fail to teach or suggest the limitation of a printed image being applied to a reflective or brightly coloured layer by a printing process.

Under 35 U.S.C. § 103(a), a prima facie case of obviousness is established only if the cited reference teaches or suggests each of the limitations of a recited claim. *In re Bell*, 991 F.2d 781 (Fed. Cir. 1993). Because Amon et al., Vilaprinyo Oliva, and Brawner et al. fail to teach or suggest each of the elements of amended Claim 1, Applicants respectfully request the withdrawal of the pending rejection under § 103(a) with regard to Claim 1. Accordingly, Applicants request that the Examiner also withdraw the pending rejections to Claims 2-7, which depend from allowable Claim 1.

Independent Claim 1 further recites "at least part of said raised printed image having a height of at least 5 μm ." As stated above, the cited references fail to teach a printed image applied to a reflective or brightly coloured layer by a printing process. Because these references do not teach the use of a printed layer, Applicants assert that the references could not teach or suggest the height of the printed image of at least 5 μm , as recited in Claim 1. Although the Office Action contends that one of ordinary skill in the art would have been motivated to vary the image thickness to ensure visibility from an angle, Applicants assert that the selection of at least 5 μm as a height for at least a portion of the raised printed image, taken in combination of the remaining limitations of Claim 1, further point out and distinguish over the cited and applied

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

B

references. Accordingly, one skilled in the art could not modify the cited and applied art, as suggested in the Office Action, because no such layer is taught or suggested.

As a general rule, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992). Applicants respectfully assert that one of ordinary skill in the art would not have been motivated from the teachings of the cited and applied references to vary the image thickness to arrive at Applicants' claimed invention. Therefore, for at least the arguments set forth above, Applicants submit that a *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request the pending rejection of Claim 1 under 35 U.S.C. § 103(a) be withdrawn. Moreover, Applicants request that the Examiner also withdraw the pending rejections of Claims 2-7, which depend from allowable Claim 1.

New Claims 15-20

New Claims 15-20 have been added to further point out and distinctly claim the novel aspects of the present invention. Applicants submit that none of the prior art, alone or in combination, teach or suggest Applicants' invention as recited in Claims 15-20. Therefore, Applicants submit that new Claims 15-20 are allowable over the prior art.

///

///

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

B

CONCLUSION

In conclusion, applicants submit that the claims of the present application are allowable over the cited and applied references. If any further questions remain, the Examiner is invited to telephone applicants' attorney at the number listed below.

Respectfully submitted,

CHRISTENSEN O'CONNOR
JOHNSON KINDNESS^{PLLC}



Brandon C. Stallman
Registration No. 46,468
Direct Dial No. 206.695.1708

I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to the Commissioner for Patents, Washington, D.C. 20231, on the below date.

Date: July 17, 2001



BCS:yc

B